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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/030,832    02/26/98    HANNA    M    1488.0950001

HM12/1208  
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EXAMINER

HAYES, R

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

12/08/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/030,832

Applicant(s)  
Hanna et al

Examiner  
Robert C. Hayes

Group Art Unit  
1645

☒ Responsive to communication(s) filed on Aug 10, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 10 and 27-157 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 10 and 27-157 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 27-94 & 148-157, drawn to isolated nucleic acids that encode ET2 polypeptides, vectors and host cells comprising such, as well as methods of producing the polypeptide, classified in Class 435, subclass 96.1.
  - II. Claims 95-147, drawn to isolated nucleic acids that encode GABRE polypeptides, vectors and host cells comprising such, as well as methods of producing the polypeptide, classified in Class 435, subclass 96.1.
  - III. Claim 10, drawn to purified ET2 polypeptides, classified in Class 530, subclass 350.

2. The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relation of Inventions" in MPEP 806.05 for inventive groups that are directed to different products; restriction is deemed proper because these products appear to constitute patently distinct inventions for the following reason:

Groups I-III are directed to products that are physically and functionally distinct that include polypeptides and polynucleotides. All of these products can be prepared by different processes, such as though chemical synthesis or isolation from natural sources using various

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isolation/purification procedures. For example, the proteins of Group III are structurally and fundamentally different molecules than the polynucleotide molecules of Groups I or II, and vice versa. Additionally, the proteins of Group II do not require the vectors and host cells of Groups I or II, and vice versa. The polynucleotides of Group I are distinguished from the polynucleotides of Group II because they encode distinct proteins, as illustrated by their unique SEQ ID NOs. The proteins of Group III are further distinguished from the polynucleotides of Group III, in that they are not encoded by the polynucleotides of Group II, and vice versa. It is pointed out that there is a proper distinction between these groups, since each product is not required in order for the other to exist. Thereby, these groups are distinct and separable for the reasons stated.

Because these inventions are distinct for the reasons given above, they have acquired a separate status in the art as shown by their different classification, and the non-coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider all the separable groups, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 305-3995. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.  
December 6, 1999



ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600